

REMARKS

Applicants have thoroughly considered the Examiner's remarks in the April 15, 2009 Office action. No new matter has been added. Reconsideration of the application in view of the following remarks is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-21 and 24 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Reed et al. (US 2002/0095454) in view of Thomas et al. (US 2003/0004917), further in view of Border et al. (US 2002/0071436) and further in view of Thomas et al. (EP 1 271 320 A1). Applicants respectfully submit that none of the cited references, alone or in combination, render these claims unpatentable.

Reed teaches a system for transferring data, metadata and methods from a provider computer to a consumer computer through a communications network. Border discloses a system for a proxy architecture. As correctly stated by the Examiner, neither Reed nor Border, separately or together, disclose every feature set forth in the claims. For example, the Examiner acknowledges that these two references fail to disclose "setting the trackingGUID equal to the syncGUID" (Office action, page 4, paragraph 5); and "sending the sync notification to the client device if the current time is less than the timeout, said timeout being used to determine the maximum time between sync notifications; and sending the sync notification to the client device if the current time is greater than timeout" (Office action, pages 4 and 5, paragraph 7).

Moreover, the Thomas references cannot be used as the basis for a rejection under section 103(a) because they are owned by Microsoft Corporation, Redmond WA, the assignee of the present application. Under 35 U.S.C. § 103(c)(1):

"Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, **shall not preclude patentability** under this section where **the subject matter and the claimed invention were**, at the time the claimed

invention was made, owned by the same person or **subject to an obligation of assignment to the same person.**" (Emphasis added)

In this instance, the two Thomas references, do not qualify as prior art under the various subsections of 35 U.S.C. § 102, except possibly § 102(e). Applicants note that the '917 Publication issued as US Patent 6,901,415 and that the European '320 publication claims priority from US Patent 6,952,708. The '415 and '708 patents both have the same filing date (June 27, 2001) and publication date (January 2, 2003).

Applicants submit herewith a Declaration under 37 C.F.R. 1.131 and accompanying evidence (Exhibits A-G) that establish Applicants' invention date and due diligence from prior to January 2, 2003, the earliest known publication date of the Thomas references. The evidence specifically shows conception and diligence towards reduction to practice prior to January 2, 2003 along with diligence in preparing the present patent application until November 21, 2003, when the present patent application was filed.

In terms of establishing prior art, and since the invention date of the present patent application predates the publication date and public knowledge of the subject matter of the Thomas patents as explained above and established in the accompanying Declaration, Applicants submit that the Thomas references do not qualify as prior art under the various subsections of 35 U.S.C. § 102 except possibly § 102(e), which states in part:

"the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) **a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent**, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language" (Emphasis added)

Hence, under section 103(c)(1), the Thomas references are not prior art because the subject matter of these references and that of the present patent application are commonly owned. Since the rejection based on the Thomas patents is improper and since the other cited references, Reed and Border, do not disclose substantial aspects the pending claims, Applicants request that the 35 U.S.C. § 103 rejection of claims 1-21 and 24 be withdrawn.

Applicants hereby submit the following enclosures to support these remarks.

1. Declaration under 37 C.F.R. 1.131, signed by the Applicants of the present patent application.
2. Exhibits A-G in support of the Declaration.
3. Recorded Assignment dated November 21, 2003 for the present patent application. Reel/Frame: 014740/0109.
4. Recorded Assignment dated June 27, 2001 for US Patent 6,901,415. Reel/Frame: 011949/0050.
5. Recorded Assignment dated June 27, 2001 for US Patent 6,952,708. Reel/Frame: 011948/0992.

Conclusion

Applicants submit that the claims are allowable for at least the reasons set forth herein. Applicants thus respectfully submit that claims 1-21 and 24 as previously filed are in condition for allowance and respectfully request favorable reconsideration of this application.

Although the art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited claims. The fact that Applicants may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicants' agreement therewith.

Applicants wish to expedite prosecution of this application. If the Examiner deems the application to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the application in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency or credit any overpayment of any required fee during the entire pendency of this application to Deposit Account No. 19-1345.

Respectfully submitted,

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